

REMARKS

Claims 1-49 are pending in this application. By this Amendment, claims 1-5 and 18 are amended. A Request for Continued Examination is filed concurrently with this response. Reconsideration based on the above amendments and following remarks is respectfully requested.

I. The Claims Are Definite

The Office Action, on page 2, rejects claims 1-5 and 18 under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, one of the features recited in the claims is asserted to lack antecedent basis. Claims 1-5 and 18 are amended to obviate the rejection. Accordingly, reconsideration and withdrawal of the rejection of claims 1-5 and 18 under 35 U.S.C. §112, second paragraph, are respectfully requested.

II. The Claims Are Allowable Over The Combination Of Barrett And Arcuri

The Office Action, on page 2, rejects claims 1, 4, 6-10, 13, 23, 27, 31, 35 and 48 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,880,727 to Barrett et al. (hereinafter "Barrett") and U.S. Patent No. 6,121,968 to Arcuri et al. (hereinafter "Arcuri"). This rejection is respectfully traversed.

At the outset, it should be noted that the July 11 Advisory Action states that "Applicant's primary argument is that the prior art references are improperly combined and that there is no suggestion to combine the references. The Examiner does not agree...." The Advisory Action goes on to provide the Examiner's rationale. However, the Advisory Action fails to address other significant points raised in the Applicant's response.

Applicant respectfully asserts, as discussed in more detail below, that "(a) the applied prior art references are improperly combined (this being one of, and not "the primary," argument Applicant made in the June 9 Amendment After Final Rejection); (b) the Office Action cites no specific teaching or suggestion to combine the applied prior art references;

and (c) any permissible combination of the applied references would not have suggested the combination of all of the features recited in the claims. Finally, Applicant also argues that combining the primary references with other various references does not overcome enumerated shortfalls in the application of the primary references to the claimed subject matter. These several arguments are not addressed in the Advisory Action. If the rejections are maintained, the Examiner must address each of these points.

Barrett teaches a system and method that enables an assignment of a feature value from a set of preset values for a copy operation to be performed in a reprographic system (Abstract). The system and method taught by Barrett involves a series of preset, pre-formatted user screens on a display device. Specifically, for example, Fig. 4 displays a substantial number of function options, among which are a plurality of buttons marked "Other." Further, with reference Figs. 4-6, a series of preset, pre-arranged function options are displayed. Applicant respectfully submits that there is no disclosure or suggestion of a display arrangement control device that determines an arrangement of the plurality of user-selectable image forming function options, and arranges the plurality of user-selectable image forming function options in the determined arrangement.

Arcuri teaches drop-down menus provided by a computer program in two states -- a short menu state and a long menu state -- indicating that when a user opens a desired menu, the menu opened will initially take the form of a short menu of executable commands which are a subset of the total number of executable commands available under the selected menu (Abstract).

Independent claims 1 and 4 recite, among other features, a display arrangement control device that determines an arrangement of the plurality of user-selectable image forming function options, and arranges the plurality of user-selectable image forming function options in the determined arrangement, wherein a plurality of the available user-selectable

image forming function options are displayed in a first case, less than all of the plurality of the user-selectable image forming function options that are displayed in the first case are displayed in a second case, and all user-selectable image forming function options displayed in the second case are displayed in the first case, the display arrangement control device modifying the display on the display unit from the first case to the second case.

According to Barrett, preset screens are displayed depending on input by a user. Thus, there is no need for any determination by a display arrangement control device. Therefore, Applicant respectfully submits that Barrett neither teaches nor suggests such a feature. Further, any attempt to provide any manner of display arrangement control device would upset the preset, pre-formatted configurations of the screens taught by Barrett. As such, any combination would require an impermissible change in the principle of operation of the Barrett device.

A. The Applied Prior Art References Are Improperly Combined

Applicant respectfully submits that the adaptive menus taught by Arcuri regarding a series of executable commands in a computer program are not combinable with the teachings of Barrett regarding a plurality of image forming function options in an image forming apparatus. Given the teachings of Barrett, it would not have been obvious for one of ordinary skill in the art to apply the teachings of Arcuri to modify the Barrett system to result in the subject matter of the claims. For example, mouse clicks in a computer program would not be readily combined with user-selectable image forming function options in an image forming apparatus. This specific argument is not addressed in the Advisory Action.

B. The Office Action Cites No Specific Teaching Or Suggestion To Combine The Applied Prior Art References In A Manner That Would Not Change The Principle Of Operation Of The Primary Reference To Barret

Applicant notes that the Office Action provides no reference to any specific teaching or suggestion in either of the prior art references that would have made it obvious to one of ordinary skill in the art to modify Barrett with the teachings of Arcuri to obtain a system such as is recited in the claims. Applicant respectfully submits that, despite the blanket conclusory statement to the contrary in the Office Action, the features recited in the claims would not have been obvious to one of ordinary skill in the art given the combined teachings of the applied references.

MPEP §2143.01 instructs, "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." Further, this section states that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests

the desirability of the combination." MPEP §2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" *See also in re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Such has not been shown here. As such, Applicant respectfully submits that the rejection of at least independent claims 1 and 4 is improper. In stating the rejection, the Office Action asserts that it would have been obvious to include a dynamic changing selection menu such as that taught by Arcuri in the invention of Barrett. The Office Action indicates that such a combination would provide users with an ability to dynamically change the available commands in a given short menu based upon the particular needs and utilization behavior of the user. This conclusory statement lacks the required specific evidence of a teaching, suggestion or motivation to one of ordinary skill that such a need was recognized in the invention of Barrett. Applicant respectfully submits that the combination of the applied references to attempt to find all of the combinations of features in the enumerated claims to have been obvious is arrived at only through the application of improper hindsight reasoning given Applicant's disclosure.

The July 11 Advisory Action again repeats the conclusory statement indicated above, expressing it in slightly more detail, and pointing Applicant to col. 1, lines 61 - col. 2, line 8 of Arcuri as providing the evidentiary basis for this conclusion. Applicant repeats that there is no specific evidence of the teaching, suggestion or motivation to one of ordinary in the art that the stated need was recognized in the invention of Barrett that would have made the combination of these references obvious to one of ordinary skill in the art. Further, as is noted above, any such combination of these particular references would have required an impermissible change in the principle operation of the Barrett device.

C. Any Permissible Combination Of Barrett and Arcuri Would Not Have Suggested The Combination Of All Of The Features Recited In The Claims

Even if Barrett and Arcuri were combinable, the resulting system would not be the same as that recited in at least independent claims 1 and 4. In Arcuri, whether the short menu or the long menu is displayed, individual executable commands are not arranged in a potentially changing arrangement as may be determined by a display arrangement control device. As such, Arcuri cannot reasonably be read to overcome the shortfall of Barrett in failing to provide a display arrangement control device that determines an arrangement of the plurality of user-selectable image forming function options, and arranges the plurality of user-selectable image forming function options in the determined arrangement.

The July 11 Advisory Action completely ignores this argument as well. Neither the Office Action nor the Advisory Action has shown any passage in either of the applied references that can reasonably be considered to teach, or even to have suggested, the above-recited feature of a display arrangement control device that determines an arrangement ... and arranges the plurality of user-selectable image forming function options in the determined arrangement. All references in both Barrett and Arcuri regard pre-determined arrangements, and make no reference whatsoever to any display arrangement display control device.

For any of the above reasons, Applicant respectfully submits that the combination of the applied references cannot reasonably be read to have rendered obvious the subject matter recited in at least independent claims 1 and 4. Further, claims 6-10, 13, 23, 27, 31, 35 and 48 would also not have been rendered obvious by the combination of Barrett and Arcuri at least for their dependence on independent claims 1 and 4, as well as for the separately patentable subject matter which each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejection of rejects claims 1, 4, 6-10, 13, 23, 27, 31, 35 and 48 under 35 U.S.C. §103(a) as being unpatentable over Barrett and Arcuri are respectfully requested.

**III. Combining Barrett and Arcuri With Other References
Does Not Overcome The Above Shortfalls In The
Application Of Those References To The Claimed Subject Matter**

A. The Office Action, on page 6, rejects claims 2, 5, 11, 12, 21, 24, 15, 28, 29, 32, 33, 36-46 and 49 under 35 U.S.C. §103(a) as being unpatentable over Barrett, Arcuri and U.S. Patent No. 6,469,719 to Kino et al. (hereinafter "Kino"). This rejection is respectfully traversed.

Kino generally discloses a layout unit referring to a plurality of menu items that are substantially composed of character strings displayed in a predetermined area of a screen in a graphical user interface of a digital communication apparatus or household appliance (Abstract; col. 1, lines 17-22; and col. 3, lines 36-53) (emphasis added).

Applicant respectfully submits that Kino neither discloses nor suggests a display unit that displays a plurality of user-selectable image forming function options and a display arrangement control device that determines an arrangement of the plurality of user-selectable image forming function options, and arranges the plurality of user-selectable image forming function options in the determined arrangement, as is recited, among other features, in independent claims 2 and 5. Applicant also respectfully submits that the arguments applicable to the application of Barrett and Arcuri to claims 1 and 4 above are equally applicable regarding the application of Barrett and Arcuri to independent claims 2 and 5. Kino does not overcome the shortfall in the application of Barrett and Arcuri to any of the independent claims, specifically claims 2 and 5.

For any or all of the above stated reasons, Applicant respectfully submits that the combinations of all of the features recited in independent claims 2 and 5 are, therefore, not

rendered obvious by the combination of the applied references. Further, Applicant respectfully submits that claims 11, 12, 21, 24, 15, 28, 29, 32, 33, 36-46 and 49, based on the arguments presented above, would also not have been rendered obvious by the combination of Barrett, Arcuri and Kino, for at least the dependence of these claims on independent claims 1, 2, 4 and 5, as well as for the separately patentable subject matter which these claims recite.

As such, Applicant respectfully submits that the combination of the applied references cannot reasonably be read to have rendered obvious the combination of all of the features recited in claims 2, 5, 11, 12, 21, 24, 15, 28, 29, 32, 33, 36-46 and 49.

Accordingly, reconsideration and withdrawal of the rejection of claims 2, 5, 11, 12, 21, 24, 15, 28, 29, 32, 33, 36-46 and 49 under 35 U.S.C. §103(a) as being unpatentable over Barrett, Arcuri and Kino are respectfully requested.

B. The Office Action, on page 11, rejects claims 3, 22, 26, 30, 34 and 37 under 35 U.S.C. §103(a) as being unpatentable over Barrett, U.S. Patent No. 5,754,179 to Hocker et al. (hereinafter "Hocker"), and Arcuri. This rejection is respectfully traversed.

In like manner to the discussion of claims 1, 2, 4 and 5, for at least the arguments made above, the combination of Barrett and Arcuri neither discloses nor suggests all of the features recited in independent claim 3. Further, Hocker teaches a capability to allow a user to rapidly determine interrelatedness of icons on a graphical user interface (Abstract) (emphasis added). Specifically, Hocker teaches substantially that when an icon is selected, other related icons are then distinguished by one of a plurality of distinguishing features, such as by brightening, by rounded corners, or by an oval shape and/or highlighted text (col. 1, line 67 - col. 2, line 4).

Applicant respectfully submits that a preset arrangement of icons wherein, based on a selection of one certain icon, other icons are highlighted and/or have their shape provisionally modified based on the selection of that first icon does not overcome the shortfall in the

application of Barrett and Arcuri to the features recited in independent claim 3. Specifically, the combination of the applied references neither teaches nor suggests a display arrangement control device that determines an arrangement of the plurality of user-selectable image forming function options, and arranges the plurality of user-selectable image forming function options in the determined arrangement, wherein a plurality of the available user-selectable image forming function options are displayed in a first case, less than all of the plurality of the user-selectable image forming function options that are displayed in the first case are displayed in a second case, and all user-selectable image forming function options displayed in the second case are displayed in the first case, the display arrangement control device modifying the display on the display unit from the first case to the second case so that at least one of the user-selectable image forming function options displayed in both cases is displayed in a shape which is different in the first case than in the second case, as recited, among other features, in claim 3.

Further, Applicant respectfully submits that claims 22, 26, 30, 34 and 37, based on the arguments presented above, would not have been rendered obvious by the combination of Barrett, Hocker and Arcuri, for at least the dependence of these claims on other allowable independent claims, as well as for the separately patentable subject matter which these claims recite.

Accordingly, reconsideration and withdrawal of the rejection of claims 3, 22, 26, 30, 34 and 37 under 35 U.S.C. §103(a) as being unpatentable over Barrett, Hocker, and Arcuri are respectfully requested.

C. The Office Action, on page 13, rejects claims 14-49 under 35 U.S.C. §103(a) as being unpatentable over Barrett, Kino, Hocker and Arcuri. This rejection is respectfully traversed.

The arguments set forth above in traversing the prior art rejections of independent claims 1-5 apply equally to the application of Barrett and Arcuri to independent claims 14 and 18. Additionally, Applicant respectfully submits that dependent claims 15-17, 19 and 20, depending from claims 14 and 18, are also neither taught nor suggested by the combination of the applied references at least for the respective dependence of these claims on independent claims 14 and 18. Further, Applicant respectfully submits that claims 21-49, depending variously from claims 2-5, are allowable at least for their dependence on independent claims 2-5 in like manner to claims 7-13 depending from claim 1, and for the reasons and arguments that the subject matter of each of the independent claims 1-5, and therefore the claims depending respectively therefrom, as argued above, are allowable. Claims 21-49 recite the same dependent features with respect to each of the independent claims 2-5 as do claims 7-13 with respect to independent claim 1.

None of the above arguments regarding the allowability of any of the dependent claims are addressed in the July 11 Advisory Action.

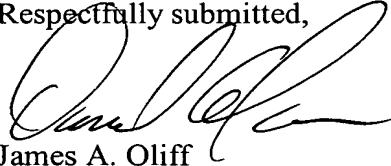
Accordingly, reconsideration and withdrawal of the rejection of claims 14-49 under 35 U.S.C. §103(a) as being unpatentable over Barrett, Kino, Hocker and Arcuri are respectfully requested.

IV. Conclusion

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-49 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number set forth below.

Respectfully submitted,



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Attachments:

Petition for Extension of Time
Request for Continued Examination

Date: August 5, 2005

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